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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/892,043
Filing Date: June 26, 2001
Appellant(s): MCINTYRE, DALE F.

MAILED

JAN 26 2007

Technology Center 2100

Frank Pincelli
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/07/06 appealing from the Office action mailed 07/22/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,321,231	Jebens et al.	11-2001
5,737,491	Allen et al.	04-1998
6,381,636	Cromer et al.	04-2002
6,035,323	Narayan et al.	03-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 12-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,321,231 issued to Jebens et al. ("hereinafter Jebens") and US Patent No. 5,737,491 issued to Allen et al. (hereinafter "Allen") and further in view of US Patent No. 6,381,636 issued to Cromer et al., (hereinafter "Cromer").

As per claims 1, 12 and 24, Jebens discloses "a method comprising the steps of:

"automatically initiating the obtaining of instructions stored on a user computer over said communication network by a service provider" as a means for receiving instructions from the first user directing that the electronic file be delivered to a second user, and automatically routing the electronic file, (see col. 3, lines 5-10), and further, in column 18, line 63 to column 19, line 10, Jebens discloses the hot-folder system automatically moves the files to a processing queue and then compresses the file per

predetermined compression settings, in which the communication portion of the local computer then establishes a connection with the host site.

Jebens does not explicitly disclose said instructions being associated with a digital media file stored on said user computer; and implementing said instructions with respect to said associated digital image file. However, Allen discloses a memory for storing digital images produced by the image sensor in digital image files, the digital image files having associated information for controlling a remote image fulfillment server, (see Allen col. 1, lines 36-45). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined teachings of Jebens and Allen with said instructions being associated with a digital media file stored on said user computer; and implementing said instructions with respect to said associated digital image file. Such modification would allow the teachings of Jebens and Allen to improve the accuracy and the reliability of the method and system for managing images over a communication network using user provider instructions, and to provide a choice of different communication relay services, (see col. 1, lines 59-60). While, Jebens and Allen disclose the claimed subject matter except the claimed an automatic service over a communication network to a user based on stored instructions by a user on a user computer. However, Cromer discloses the claimed a server computer system to remotely access asset information stored within a client computer system coupled to the server utilizing a network, in which asset information is stored within each client which includes information identifying software components of the particular client (see Cromer col. 3, lines 16-37) and column 2, lines 15-26. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined teachings of Jebens and Allen and Cromer with claimed an automatic service over a communication network to a user based on stored instructions by a user on a user computer. Such modification would allow the teachings of Jebens and Allen and Cromer to provide a path to allow software running on client to access application integrated circuit, (see Cromer col. 5, lines 65-66).

As per claims 2 and 14, Jebens discloses "where said instruction comprises instructions relating the sale of rights to use and/or reproduce said image", (see col. 9, lines 47-51).

As per claims 3 and 15, Jebens discloses "where said instruction comprises the purchase, use, or sale of an item displayed in said image" as invoices are developed by reference to the activities logged in the activity log during a pre-defined billing period, predefined ones of the events are assigned a charge by the system, all of the charges for a given image provider user are preferably automatically organized and displayed in an invoice, (see col. 17, lines 43-51).

As per claims 4 and 16, Jebens discloses "said instruction was entered on a form, (see col. 17, lines 43-46).

As per claims 5 and 17, Jebens discloses "said form is displayed in association with said image", (see col. 20, line 60 to col. 21, line 6).

As per claims 6 and 18, the limitations of claims 6 and 18 are rejected in the analysis of claim 1, and these claims are rejected on that basis.

As per claims 7 and 19, Jebens discloses "the service provider recognizes that a digital image file has been identified for a service during a routine communication interval" as the low-resolution images downloaded to the agency preferably have a relatively low bandwidth communication requirement and can be transmitted in a relatively short amount of time, (see col. 5, lines 24-35).

As per claims 8 and 20, Jebens discloses "an electronic form is provided to the user by service provider in response to discovering of the identified digital image file" as displays the status of any recently place work orders, (see Fig. 1 and col. 21, lines 46-53).

As per claim 13, in addition to claim 1, Jebens further discloses "said associated digital image file representing an image" as a means for translating the digital images received by the system into a file format defined by the first asset provider user before storing the digital images in the storage device, (see col. 27, lines 44-47).

Claims 9-11 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable US Patent No. 6,321,231 issued to Jebens et al. ("hereinafter Jebens") and US Patent No. 5,737,491 issued to Allen et al. (hereinafter "Allen") and US Patent No. 6,381,636 issued to Cromer et al., (hereinafter "Cromer") as applied to claims 2 and 14 above, and further in view of US Patent No. 6,035,323 issued to Narayen et al. (hereinafter "Narayen").

As per claims 9-11 and 21-23, Jebens and Allen and Cromer disclose the claimed subject matter except the claimed a metadata field of the identified digital image file is modified to reflect the data added to the electronic form; wherein the metadata field is provided in said service provider computer; wherein the metadata field is provided in said user computer. However, Narayen discloses the claimed a data object is created for each digital image and is stored in a database, this storage is in addition to the storage of the original file for the original image on a file storage device, the storage in the database typically is performed by a picture management system which is typically a separate piece of software which creates and stores the data object for each digital image and also which maintains the database (see Narayen col. 6, line 28 to col. 7, line 13). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined teachings of Jebens and Allen and Cromer and Narayen by a metadata field of the identified digital image file. Such a modification would allow the teachings of Jebens and Allen and Cromer and Narayen to provide a user on a client computer system to create a media container which contains digital media and publish this media container with its digital

media onto the Internet for other computer systems to be able to view the media container with its digital media, (see Narayen col. 7, lines 28-34).

(10) Response to Argument

The Examiner will address the arguments in the order submitted by the appellant(s).

Argument:

Appellant stated, page 5, paragraph 3, Jebens does not disclose, expressly or inherently, at least automatically initiating of instructions stored on a user computer as recited in independent claims 1, 12, 13 and 24.

Response:

It is noted that, Jebens discloses a means for receiving instructions from the first user directing that the electronic file be delivered to a second user, and automatically routing the electronic file; see col. 3, lines 5-10. Further, in column 18, line 63 to column 19, line 10, Jebens discloses the system automatically moves the file to a processing queue and then compresses the file per predetermined compression settings, in which the communication portion of the local computer then establishes a connection with the host site, therefore, Jebens discloses the claimed limitations automatically initiating the obtaining of instructions stored on a user computer over said communication network by a service provider.

Argument:

Appellant stated, page 8, paragraph 3, neither Jebens, Allen nor Cromer, alone or in combination, expressly or inherently teach or suggest automatically initiating the obtaining of instructions stored on a user computer over the communication network by a service provider.

Also, Appellant further stated, page 8, last paragraph, "Narayan also fails to remedy the deficiencies of Jebens, Allen and Cromer as Narayan fails to teach or suggest Narayan also fails to remedy the deficiencies of Jebens, as Narayan fails to teach or suggest automatically initiating the obtaining of instructions stored on the user computer over a communications network by a service provider.

Response:

In response to Appellant's argument, page 8, paragraphs 3 and 4, that "neither Jebens, Allen nor Cromer, alone or in combination, expressly or inherently teach or suggest automatically initiating the obtaining of instructions stored on a user computer over the communication network by a service provider." The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Jebens discloses a system automatically moves the file to a processing queue and then compresses the file per predetermined compression settings, in which the communication portion of the local computer then establishes a connection with the host site; see col. 18, line 63 to col. 19, line 10, therefore, Jebens discloses the claimed limitations automatically initiating the obtaining of instructions stored on a user computer over said communication network by a service provider.

Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Argument:

Appellant stated, page 9, paragraph (2), that claims 1, 12, 13 and 24 are patentable over Jebens, Allen, Cromer and Narayen because the references are not combinable.

Response:

In response to Appellant argument, that "claims 1, 12, 13 and 24 are patentable over Jebens, Allen, Cromer and Narayen because the references are not combinable." The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, in addition to claim 1, Jebens and Allen and Cromer disclose the claimed invention except a metadata field of the identified digital image file is modified to reflect the data added to the electronic form; wherein the metadata field is provided in said service provider computer; wherein the metadata field is provided in said user computer. However, Narayen discloses a data object is created for each digital image and is stored in a database, this storage is in addition to the storage of the original file for the original image on a file storage device, the storage in the database typically is performed by a picture management system which is typically a separate piece of software which creates and stores the data object for each digital image and also which maintains the database (see Narayen col. 6, line 28 to col. 7, line 13). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined teachings of Jebens and Allen and Cromer and Narayen by a metadata

field of the identified digital image file as disclosed by Narayen (see Narayen Fig. 4 and corresponding text). Such a modification would allow the method of Jebens to provide a user on a client computer system to create a media container which contains digital media and publish this media container with its digital media onto the Internet for other computer systems to be able to view the media container with its digital media (see Narayen col. 7, lines 28-34).

Argument:

Appellant stated, page 11, paragraph 2, "Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight."

Response:

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Thus, It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the method of Jebens and Allen by said instructions being associated with a digital media file stored on said user computer; and implementing said instructions with respect to said associated digital image file as disclosed by Allen (see Allen Figs 1 and 2). Such a modification would allow the method of Jebens to improve the accuracy and the reliability of the method and system for managing images over a communication network using user provider instructions, and to provide a choice of different communication relay services (see Allen col. 1, lines 59-60). While, Jebens and Allen disclose the claimed invention, except an automatic service over a communication network to a user based on stored instructions by a user on a user computer. However, Cromer discloses a server computer system to remotely access asset information stored within a client

computer system coupled to the server utilizing a network, in which asset information is stored within each client which includes information identifying software components of the particular client (see Cromer col. 3, lines 16-37 and col. 2, lines 15-26). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the method of Jebens and Allen and Cromer by an automatic service over a communication network to a user based on stored instructions by a user on a user computer. Such a modification would allow the method of Jebens to provide a path to allow software running on client to access application integrated circuit (see Cromer col. 5, lines 65-66).

Furthermore, Jebens discloses a system for searching and storing digital images; see col. 2, lines 15-26. Allen discloses a system providing fast delivering of digital images; see col. 1, lines 56-60. Cromer discloses client computer systems are coupled to the server computer system utilizing a network; see col. 2, lines 19-20. Narayan discloses methods and apparatuses for distributing a collection of digital media on a network; see col. 2, lines 34-40. Thus, the combination of Jebens, Allen, Cromer and Narayan discloses the claimed invention.

MPEP 2111: During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

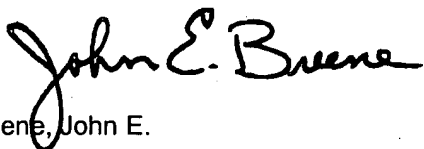


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